UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,988	06/25/2003	Anthony J. Wasilewski	A9286	5349

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EXAMINER
CHAI, LONGBIT

ART UNIT	PAPER NUMBER
2131	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	01/19/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 November 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-12</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-12</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>25 June 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   Original application contained claims 1 – 12. Claims 1 and 7 have been

amended in an amendment filed on 11/21/2006. The amendment filed have been

entered and made of record. Presently, pending claims are 1 – 12.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

11/21/2006 has been entered.

Response to Argument

3.   As per claim 1 and 7, Applicant asserts that Wasilewski does not disclose, teach,

or suggest encrypting the selected digital bit stream according to a second encryption

method to provide a second encrypted stream wherein the second encryption method is

different from the first encryption method. Examiner respectfully disagrees because

Unger teaches (a) providing partial <u>dual encryption</u> methods utilizing an additional

(secondary) PID for each duplicated component and these secondary PIDs are used to

tag packets that carry duplicated content with an additional encryption method (Unger: Para [0036]) and (b) allowing each participating CA (Conditional Access) system to be operated independently and each is orthogonal to the other – for example, packets encrypted with Motorola's proprietary encryption can use fast changing encryption keys, while packets encrypted with NDS' smart card based system use slightly slower changing keys (Unger: Para [0040]) and as such Applicant's arguments are respectfully traversed.

Priority

4.   Applicant's claims for benefit of Continuation-in-part of Application priority date under 35 U.S.C. 120 is acknowledged.

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The application is filed on 6/25/2003 but all of the claims 1 – 12 are not solely directed to originally supported subject matter present in the parent application (for example, related to partially-dual-encrypted data stream) such as newly amended claims 1 and 7 "encrypting the selected digital bit stream according to a second encryption method to provide a second encrypted stream wherein the second encryption method is different from the first encryption method".

However, the later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in

the parent application and in the later-filed application must be sufficient to comply with

the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v.*

Performance Contracting, Inc., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

As a result, all of the claims 1 – 12 will not receive benefit of the filing date of the

earlier file application, and thereby the effective filing date for the subject matter defined

in the pending claims in this application remains 6/25/2003.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that

forms the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1 – 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Unger

(U.S. Patent 2003/0026423).

As per claim 1, Unger teaches a method for providing a program in a conditional

access system, the method comprising the steps of:

selecting a digital bit stream from a plurality of digital bit streams (Unger: Para

[0055] – [0068] & Table 1 and Figure 6);

encrypting the selected digital bit stream according to a first encryption method to

provide a first encrypted stream (Unger: Table 1 and Figure 6 / E318);

encrypting the selected digital bit stream according to a second encryption

method to provide a second encrypted stream wherein the second encryption method is

different from the first encryption method (Unger: Para [0036] and Para [0040] & Table 1

and Figure 6 / E324: Unger teaches (a) providing partial dual encryption methods

utilizing an additional (secondary) PID for each duplicated component and these

secondary PIDs are used to tag packets that carry duplicated content with an additional

encryption method (Unger: Para [0036]) and (b) allowing each participating CA

(Conditional Access) system to be operated independently and each is orthogonal to

the other – for example, packets encrypted with Motorola's proprietary encryption can

use fast changing encryption keys, while packets encrypted with NDS' smart card based

system use slightly slower changing keys (Unger: Para [0040]));

multiplexing the first encrypted stream, the second encrypted stream, and the

plurality of digital bit streams to provide a partially-encrypted stream (Unger: Table 1

and Figure 6 / E322 & Para [0053] – [0058]); and

transmitting the partially-encrypted stream (Unger: Figure 6).

As per claim 7, Unger teaches a method for providing a plurality of programs in a

conditional access system, the method comprising the steps of:

selecting a plurality of elementary bit streams from a transport stream (Unger:

Para [0055] – [0068] & Table 1 and Figure 6);

encrypting a portion of the selected elementary bit stream according to a first

encryption method to provide a first encrypted stream (Unger: Table 1 and Figure 6 /

E318);

encrypting the portion of the selected elementary bit stream according to a

second encryption method to provide a second encrypted stream wherein <u>the second</u>

<u>encryption method is different from the first encryption method</u> (Unger: Para [0036] and

Para [0040] & Table 1 and Figure 6 / E324: Unger teaches (a) providing partial <u>dual</u>

<u>encryption</u> methods utilizing an additional (secondary) PID for each duplicated

component and these secondary PIDs are used to tag packets that carry duplicated

content with an additional encryption method (Unger: Para [0036]) and (b) allowing each

participating CA (Conditional Access) system to be operated independently and each is

orthogonal to the other – for example, packets encrypted with Motorola's proprietary

encryption can use fast changing encryption keys, while packets encrypted with NDS'

smart card based system use slightly slower changing keys (Unger: Para [0040]));

multiplexing the first and second encrypted streams and the remaining portion of

the selected elementary bit stream with the transport stream (Unger: Table 1 and Figure

6 / E322 & Para [0053] – [0058]); and

transmitting the multiplexed stream (Unger: Figure 6).

As per claim 2, Unger teaches a portion of the selected digital bit stream is

encrypted, wherein the encrypted portion and an unencrypted portion of the selected

digital bit stream are combined with the plurality of digital bit streams (Unger: Table 1 and Figure 6 / E322 & Para [0058] Line 13 – 16).

As per claim 3, 6, 9 and 12, Unger teaches the selected digital bit stream includes a plurality of packets, and wherein each packet includes a packet identifier identifying whether the packet is at least one of a video stream, an audio stream, and a data stream (Unger: Table 1 and Para [0010] & [0047]: there are nine program digital bit stream, as shown in Table 1, constitutes video, audio and auxiliary data packet having a particular packet identifier).

As per claim 8 (and claims 4, 5, 10, 11 and 12), Unger teaches each of the plurality of elementary bit streams includes a plurality of packets, wherein each packet includes a packet header that is indicative of at least one of a video stream, an audio stream, and a data stream (Unger: Table 1 and Para [0010] & [0047]: there are nine program digital bit stream, as shown in Table 1, constitutes video, audio and auxiliary data packet having a particular packet identifier).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Longbit Chai
Examiner
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